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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,787	10/14/2003	Frederic Dalmais	DAY 0766 PA/40195.733	2991

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EXAMINER	
KRUER, KEVIN R	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

1.p

Office Action Summary	Application No.	Applicant(s)	
	10/684,787	DALMAIS ET AL.	
	Examiner	**Art Unit**	
	Kevin R. Kruer	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 21 December 2005.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 2,4-9,21 and 22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 2,4-9,21 and 22 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 14 October 2003 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 21, 2005 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 08-027439 (herein referred to as Takemura).

Takemura teaches a curable type anticorrosive tape comprising tacky agent layers prepared by adding a rust-preventing agent. Said tacky agent layers are applied to a substrate (abstract) comprising a polymeric fiber (paragraph 0012). The substrate is herein understood to be penetrated by the tacky agent layers. Thus, the substrate is understood to contain corrosion inhibiting additives.

With regard to the limitation that the film is used "on the surface of a metal base ply of a printing blanket which contacts a printing blanket cylinder," MPEP 2111.02

states that a preamble is not considered a limitation and is of no significance to claim construction when the preamble merely states the purpose or intended use of the invention. Furthermore, the tape of Takemura would be capable of performing the recited intended use because said tape is designed to adhere two surfaces together. As noted in In re Schreiber, if a prior art structure is capable of performing the intended use as recited in the preamble, it meets the claim. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed.Cir. 1997).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 2, 4-9, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bresson et al (US 5,352,507) in view of Linska (US 4,766,811) and WO93/01003 (herein referred to as Pinkston).

Bresson teaches a multi-layered sleeve-like printing blanket that is mounted on gapless cylinders or tubular blanket carrier. The printing blanket comprises a seamless outer printing surface layer, at least one reinforced elastomer layer, and a resiliently compressible layer (abstract). The elastomer layer is reinforced by fibers substantially parallel with the inward and outward sides of the cylindrical tube ((col 5, lines 43+). Said layers are applied to a metal carrier with a thickness of greater than 0.001cm (col

8, lines 53+). As shown in FIGURE 6, the compressible layer (4) is positioned between the base layer (not shown) and the surface layer (6), and the reinforcing ply (5) is positioned between the compressible layer (4) and the surface layer(6). With regard to claim 5, the laminate further comprises a second reinforced elastomer (4b) between the surface layer and the compressible layer (FIG 6 and col 8, lines 25+). The carrier layer is mounted to a metal cylinder using an optional layer of suitable adhesive (col 5, lines 53+). Said adhesive may be a urethane adhesive (col 10, lines 59+) or other suitable pressure sensitive adhesive. Said layer of adhesive is understood to extend over substantially the entire surface of the base ply (see FIG 3, reference no 3 and col 11, lines 15+).

Bresson does not teach that the urethane adhesive layer may comprise a corrosion-inhibiting additive. However, Linska teaches a method of applying a printing blanket to a printing cylinder, which is designed to prevent corrosion of the cylinder surface. The method utilizes a double-side coated adhesive foil applied to the printing blanket. The adhesive-coated printing blanket is then wrapped about the cylinder so that the printing blanket is adhered to the cylinder by the double-side coated adhesive foil (abstract). The adhesive comprises a foil coated on both sides with a homogeneous adhesive layer (col 2, lines 46+). Said method is a cheap, easy manner in which to supply the metal cylinder with corrosion resistance (col 8, lines 18+). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the adhesive coated foil taught in Linska in place of the adhesive layer taught in Bresson. The motivation for doing so would have been to increase the corrosion resistance of the metal cylinder.

Linska does not teach the foil layer can be replaced by a polymeric layer comprising metal particles. However, Pinkston (like Linska) teaches an alternative for the nickel and chrome plating traditionally provided on printing cylinders in order to provide said cylinder with corrosion protection (top of page 2). Pinkston teaches corrosion resistance can lent to the cylinder by providing a sacrificial metal layer over the cylinder (page 4, lines 18+). The sacrificial metal may comprise a metal foil or utilizing metal particles in a polymeric binder (page 5, lines 20+). The courts have held that it is obvious to substitute one composition for a second composition when the equivalency of the compositions is recognized in the prior art (see MPEP 2141.05). Furthermore, an express suggestion to substitute one equivalent component for another is not necessary to render such substitution obvious. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a polymer layer comprising metal particles in place of the metal foil taught in Linska. The motivation for doing so would have been that said layers are known to be equivalent for providing corrosion resistance to printing cylinders. Linska teaches the particles have a diameter of 1-50um (page 6, line 3), which means the film is at least 0.0013cm thick.

With regard to claim 22, the metal carrier is herein understood to read on the claimed "base ply," the surface layer is understood to read on the claimed "surface layer," the metal particle containing layer is understood to read on the claimed "polymer in the form of a film or sheet" and the adhesive between the base layer and the foil is understood to read on the adhesive that adheres the second surface of the base ply and the "polymer in the form of a film or sheet."

Response to Arguments

Applicant's arguments filed December 21, 2005 have been fully considered but they are not persuasive.

Applicant argues there is not teaching or suggestion in Takemura that their tape would be capable of reducing corrosion and abrasion of printing blankets/cylinders when used on a printing blanket construction. The examiner maintains the position that Takemura does not have to explicitly contain said teaching or suggestion to anticipate the claim. MPEP 21 1 1.02 states that a preamble is not considered a limitation and is of no significance to claim construction when the preamble merely states the purpose or intended use of the invention.

Applicant argues they can find no evidence to support the examiner's position that the rust-prevention agent penetrates the base material of Takemura. The examiner respectfully disagrees. In paragraph 0012, Takemura teaches the fabric will hold the coating comprising the resin and additive. Furthermore, a porous substrate will inherently be penetrated by a viscous coating material. Thus, the examiner maintains the position. Applicant argues the inventive laminate comprises a non-permeable core layer. Said argument is noted but is not commensurate in scope with the claims. Thus, the rejection is maintained.

Applicant's arguments with regards of Bresson in view of Linska are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin R. Kruer
Patent Examiner-Art Unit 1773